

REMARKS

In view of the above amendments and the following remarks, reconsideration and withdrawal of the rejections of the claims is respectfully requested. Claims 1-26 currently are pending. By way of the present response, claims 1-5, 7, 9 and 18 have been amended to clarify the invention. Consequently, claims 1-26 remain pending for consideration with claims 1, 9 and 18 being independent.

In the Office Action, claims 1-8 stand rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter. In response, Applicants have amended the claims as shown above to more distinctly claim system components as supported in the specification at, for example, FIG. 1, elements 12, 18 and 20 and paragraphs [0021] to [0023] of the published application. Therefore, Applicants respectfully request that the 101 rejection be withdrawn.

Additionally, claims 1, 2, 4-7, 9-11, 13-16, 18-20 and 22-25 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,438,657 to Nakatani (Nakatani); claims 3, 12 and 21 stand rejected under 35 U.S.C. § 103(a) as being obvious over Nakatani in view of U.S. Patent No. 6,778,703 to Zlotnick (Zlotnick); and claims 8, 17 and 26 stand rejected under 35 U.S.C. § 103(a) as being obvious over Nakatani in view of U.S. Patent No. 6,519,617 to Wanderski et al. (Wanderski).

In particular, the Office asserts that Nakatani teaches: a comparison system adapted to compare one or more elements of at least a portion of an original document against the same types of elements in at least a portion each of a plurality of stored documents, wherein the portion of the original document is the portion that requires adjustment or re-layout (Abstract, col., 1, lines 52-67, and col. 2, lines 1-37: whereas, a comparison system is adapted to compare one or more data elements of a portion of one of document against the same types of plurality of given/stored documents, such that the portion of the original document is properly adjusted to reflect the layout of the stored/given document); a determination system adapted to identify the stored document with the portion which is closest to the portion of the original document based on the comparing (col. 2, lines 19-37: whereas the portions that are identified using the stored/given document are matched to the portion in the original document); and a mutation system adapted to apply one or more

mutators to the portion of the original document which were applied to mutate the portion of the identified stored document, wherein mutators include at least one of a font type adjustor, a line spacing adjustor, at least one color adjustor and at least one section location adjustor in the portion of the original document (whereas, as taught in col. 18, lines 4-55: section location/layout adjustment is implemented in the portion of the original document).

Further, the Office asserts that Zlotnick teaches a determination system further comprises a scoring system that generates a score for each of the comparisons of the portion of the original document against each of the portions of each of the plurality of stored documents, wherein the determination system identifies the stored document with the portion with the score which is closest to the portion of the original based on the generated scores (col. 2, lines 38-45: whereas, the ‘current’/original document/template is, being compared to other document/templates, and a stored document/template is selected based on the closes matching score). The Office asserts that it would have been obvious to one of the ordinary skill in the art at the time of the invention to have modified Nakatani’s determination system such that it would have included a comparison ranking system for selection of the closest matched stored document as taught by Zlotnick. The combination of Nakatani and Zlotnick would have allowed Nakatani’s system to have “provided improved methods for automatically identifying which of a plurality of templates (documents) corresponds to a given form document” (Zlotnick, col. 2, lines 10-14).

Still further, the Office asserts that Wanderski teaches a system comprising storing the output, original document with the applied mutators as one of the stored documents (col. 14, lines 48-52: whereas, the DTD contains one or more mutators for the document, and the generated output can be stored for later processing). The Office asserts that it would have been obvious to one of the ordinary skill in the art at the time of the invention to have modified Nakatani’s system to have further included the ability to store the output as one of the stored documents as taught by Wanderski. The combination of Nakatani and Wanderski would have allowed Nakatani’s system to have “automatically transformed documents using dynamically –selected transformations” (Wanderski, column 4, lines 13-14).

With respect to independent claims 1, 9 and 18, as amended, neither Nakatani, Zlotnick nor Wanderski, alone or in combination, teach or suggest a method, system, or

medium for dynamic document layout including the features of “wherein the one or more mutators include a font type adjustor, at least one color adjustor and at least one of a line spacing adjustor and at least one section location adjustor in the portion of the original document.” (See, for example, paragraphs [0020] to [0023] of published application).

To establish anticipation under 35 U.S.C. § 102(b), the Examiner must show that each and every feature recited in these claims is either explicitly disclosed or “necessarily present” in a single prior art reference, such as within the four corners of the Nakatani patent. *See M.P.E.P. § 2131(7th ed. 1998); In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999); *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1269 (Fed. Cir. 1991). To support a conclusion of anticipation, the Examiner must specifically identify “substantial evidence” setting forth why and how the single prior art reference anticipates each and every feature recited in the claims. *See In re Mullin*, 481 F.2d 1333, 1336-37 (CCPA 1973) (An Examiner’s bare assertion that claims were obviously anticipated by a reference did not inform the Applicant as to why the claims lacked novelty); *Dickinson v. Zurko*, 527, U.S. 150 (1999) (The U.S. Patent Office’s findings of fact must be reviewed by the substantial evidence standard).

Viewed against this backdrop, each of the Examiner’s factual conclusions must be supported by “substantial evidence” in the documentary record. See *In re Lee*, 61 U.S.P.Q.2d 1430, 1432 (Fed. Cir. 2002). The Examiner has the burden of documenting all findings of fact necessary to support a conclusion of anticipation or obviousness “less to ‘haze of so-called expertise’ acquire insulation from accountability.” Id. To satisfy this burden, the Examiner must specifically identify where support is found within the prior art to meet the requirements of 35 U.S.C. §§ 102(b). In this case, however, the Examiner cannot satisfy his burden of demonstrating how Nakatani, taken alone or in combination with any other prior art reference, can either render obvious each and every one of the limitations present in independent claims 1, 9 and 18 as required by the Manual of Patent Examining Procedure (“MPEP”) and Federal Circuit jurisprudence.

In contrast, the teachings of Nakatani are directed to document data stored in a document storage area are extracted line by line to analyze the structure of the document data. The document layout information is extracted from the analysis result. The extracted layout

information is stored, as learning data, in a document layout information learning area. In format conversion, the document data to be output, which is extracted in the same manner as described above, is converted on the basis of the learning data. Document data having a consistent layout is output to a CRT or a printer in accordance with the converted layout information. However, Nakatani does not teach or suggest the features of one or more mutators include a font type adjustor, at least one color adjustor and at least one of a line spacing adjustor and at least one section location adjustor in the portion of the original document, as presently claimed. Applicants contend that the section location/layout adjustment as disclosed in Nakatani cannot read on the mutators, as claimed and supported in paragraphs [0020] to [0023] of the published application.

For anticipation under 35 U.S.C. § 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present (M.P.E.P. 706.02). Since each and every element, as set forth in the claims are not found either expressly or inherently described as required by the M.P.E.P., Nakatani cannot be said to anticipate the invention as claimed. Hence, withdrawal of the rejection is respectfully requested.

Similarly, Zlotnick and Wanderski fail to cure the deficiencies in Nakatani, as discussed above. Accordingly, amended independent claims 1, 9 and 18 are allowable over the applied references, taken alone or in combination. Thus, in accordance with the M.P.E.P. § 2143.03, to establish a *prima facie* case of obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 409 F.2d 981, 180 USPQ 580 (CCPA 1974). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 196 (CCPA 1970). Therefore, it is respectfully submitted that neither Nakatani, Zlotnick nor Wanderski, taken alone or in any proper combination, discloses or suggests the subject matter as recited in claims 1, 9 and 18. Hence, withdrawal of the rejection is respectfully requested.

Each of the dependent claims depend from one of independent claims 1, 9 or 18 and are patentable over the cited prior art for at least the same reasons as set forth above with respect to claims 1, 9 and 18.

In addition, each of the dependent claims also recite combinations that are separately patentable.

In view of the foregoing remarks, this claimed invention, as amended, is not anticipated or rendered obvious in view of the prior art references cited against this application. Applicants therefore request the entry of this response, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

In discussing the specification, claims, and drawings in this response, it is to be understood that Applicants in no way intend to limit the scope of the claims to any exemplary embodiments described in the specification and/or shown in the drawings. Rather, Applicants are entitled to have the claims interpreted broadly, to the maximum extent permitted by statute, regulation, and applicable case law.

Should the Examiner believe that a telephone conference would expedite issuance of the application, the Examiner is respectfully invited to telephone the undersigned agent at (202) 585-8100.

Respectfully submitted,

Date: January 22, 2009

/Sean A. Pryor, Reg. #48103/
Sean A. Pryor

NIXON PEABODY LLP
Clinton Square, P.O. Box 31051
Rochester, New York 14603-1051
Telephone: (585) 263-1014
Facsimile: (585) 263-1600